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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,814	09/27/2000	Kaname Kono	029493/0138	5929

7590

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Michael D Kaminski
FOLEY & LARDNER
Suite 500
3000 K Street NW
Washington, DC 20007-5109

EXAMINER

WESSMAN, ANDREW E

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 06/18/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=7

Office Action Summary

Application No.

09/671,814

Applicant(s)

KONO, KANAME

Examiner

Andrew E Wessman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 1-5 remain for examination. New claims 6-12 have been added. Claims 8-12 have been withdrawn from consideration.

Election/Restrictions

2. Newly submitted claims 8-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions claims 8-12 and claims 1-7 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process, such as forging.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the term "may be" is indefinite as it fails to recite an active step in practicing the invention, and it is unknown whether the limitation is necessary to the practice of the invention. As such, the scope of the claim is indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalpakjian textbook or Marder et al.

Kalpakjian and Marder et al. are applied to the claims for the reasons set forth in paper No. 4, paragraphs 5 and 6.

In regards to the amended features of claim 1, wherein the part has a thickness of less than 1mm and the surface is sufficiently smooth so that the surface may be painted directly without further processing, these features are already taught in the cited prior art. Kalpakjian teaches (page 263, 2nd paragraph) that parts made from such die casting operations require little or no subsequent machining or finishing operations, and because Kalpakjian discloses similar processes having good dimensional accuracy, it would have been expected that the processes disclosed by Kalpakjian would be

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capable of producing products with thickness less than 1mm. Marder et al. teaches (col. 9, lines 19-29) that parts can be made as thin as 0.019 inches (0.48mm). Marder et al. also teaches a process for making products similar to those of the claimed invention, and teaches that such products are precision, net-shape products (col. 3, lines 39-41). It would have been expected that such products produced by the Marder et al. process would require little or no further processing and could be painted directly without further processing.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marder et al.

The teachings of Marder et al. are discussed in paper No. 4, paragraph 6.

In regards to the features of claim 6, Marder et al. teaches (col. 9, lines 19-29) that thin castings made by the method of Marder et al. can have thickness as low as 0.019 inches, or 0.48mm. The scope of this teaching includes castings with thickness ranging from 0.5 to 1mm.

In regards to the features of claim 7, Marder et al. does not specifically teach a molded metal part having dimensions of approximately 21.0cm by approximately 29.7cm. However, the processes by which the articles of Marder et al. and the claimed invention are made are substantially the same, and both processes are shown to make articles with approximately the same thickness, and so it would have been expected by one of ordinary skill in the art that the process of Marder et al. would be useful for creating die cast products of the same dimensions as the claimed invention.

Response to Arguments

8. Applicant's arguments filed March 29, 2002 have been fully considered but they are not persuasive. In the remarks, applicant argues that the prior art neither teaches nor suggests making an article of the dimensions of the claimed invention and with a surface requiring no further processing. However, as pointed out in paragraphs 6 and 7, the prior art of Kalpakjian does in fact teach die cast articles requiring little or no further processing, and Marder et al. teaches articles having the same thickness as those of the claimed invention. While applicant also argues that the method of the claimed invention is not taught by the prior art, determination of the patentability of a product in product-by-process claims is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Claims directed solely to the process in this case have been withdrawn from consideration as being drawn to non-elected statutory subject matter.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
June 14, 2002


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700